



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/560,906	06/07/2007	Bernd Jung	0070681-000034	2365
21839 7590 04/21/2011 BUCHANAN, INGERSOLL & ROONEY PC POST OFFICE BOX 1404 ALEXANDRIA, VA 22313-1404			EXAMINER ZIMMER, MARC S	
			ART UNIT 1765	PAPER NUMBER
			NOTIFICATION DATE 04/21/2011	DELIVERY MODE ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

ADIPFDD@bipc.com
offserv@bipc.com

Office Action Summary	Application No. 10/560,906	Applicant(s) JUNG ET AL.	
	Examiner MARC S. ZIMMER	Art Unit 1765	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 April 2011.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 10-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 10-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(c)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 10-14, 16-23, and 25 are rejected under 35 U.S.C. 102(b) as being anticipated by Okami et al., U.S. Patent # 5,216,104.

It is now noted that Example 2 anticipates every element of claims 10, 13, 14, 17-23, and 25.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 11-12 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Okami et al., U.S. Patent # 5,216,104.

Example 2 does not indicate what is the Si-Vinyl:SiH but column 4, lines 64-68 contemplate adding enough of the organohydrogensiloxane so as to provide ratios preferably from 1:1 to 3:1.

As for the separation of the composition of into multiple parts where at the crosslinking agent is segregated from the platinum catalyst, this is widely practiced so

as to ensure the storage stability of the materials and, thus, it would be obvious to store the composition of the prior art in a similar fashion to realize a similar benefit.

Claims 10-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ozai et al., U.S. Patent Application Publication No. 2003/0220448 in view of Okami, U.S. Patent # 5,206,104 for the reasons outlined previously.

Based on the Examiner's previous remarks, Applicant has filed a response that includes a copy of the product data sheet for Rhodorsil® RT Gel 8260. However, the description of the makeup of the gel-forming composition offered by the data sheet is so vague that none of the Examiner's concerns have been alleviated.

Surely, Applicant appreciates that, in order for it to be possible to be able to identify the source of the differences in the performance characteristics between the Example and the Comparative Example, the Examiner must know as much about the two compositions as possible. The supplied product data sheet does not assist the Examiner at all in this regard so perhaps the following more pointed questions will help Applicant better understand what is needed for a proper comparison:

(i) The Specification says of the polyorganohydrogensiloxane component that it is a "poly(dimethylsiloxy)(siloxymethylhydro)- α,ω - dimethylhydrosiloxy oil... with a viscosity of 10 mPa's and comprising 5-10% by weight of SiH groups". **Note: this, in itself, is a fairly imprecise characterization of this component. It is not clear why Applicant shouldn't be able to provide an exact hydrosilyl group weight contribution figure for the particular sample used in this trial.**

The product data sheet gives none of these details about the corresponding organohydrogensiloxane of Rhodorsil® RT Gel 8260. Does it have the same viscosity and also the same SiH group content? If not, how can the Examiner be sure that the differences in properties are not attributable to this distinction?

(ii) The Specification indicates that the vinyl-functional polysiloxane is one that has, "a viscosity of 300 mPa's comprising approximately 0.1% by weight vinyl groups. The product data sheet gives none of these details about the corresponding vinyl-functional polysiloxane of Rhodorsil® RT Gel 8260. Does it have the same viscosity and also the same vinyl group content? Does it have the same placement of the vinyl groups, i.e. at the terminals as opposed to pendant to interior silicon atoms? If not, how can the Examiner be sure that the differences in properties are not attributable to this distinction?

(iii) Is the Si-Vi:SiH ratio the same in Rhodorsil® RT Gel 8260? If not, how can the Examiner be sure that the differences in properties are not attributable to this distinction?

It is the hope of the Examiner that Applicant will now better comprehend what kind of information would be necessary for the Examiner to be able to ascertain what exactly is driving the performance differences.

Because the Examiner is now holding most of the claims as anticipated over Okami alone, the rejection will not be made final. It is sincerely regretted that Applicant had not been afforded the opportunity to address this matter earlier.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MARC S. ZIMMER whose telephone number is (571)272-1096. The examiner can normally be reached on Monday-Friday 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jim Seidleck can be reached on 571-272-1078. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

April 12, 2011

/Marc S. Zimmer/
Primary Examiner, Art Unit 1765